Amendment to the Drawings:

Add the new sheet of drawings containing new Figure 3.

Attachment: One new sheet drawings.

REMARKS

As may be appreciated from the above amendments to the drawings and the specification, the specification and drawings have been amended. A payment for a one month extension of time is provided with this Amendment. Further, authorization is provided herewith to pay any underpayment of fees or credit any overpayment of fees to Deposit Account No. 02-4800.

I. RESPONSE TO THE OBJECTION TO THE DRAWINGS

The Examiner previously accepted the drawings of the application in the Office Action mailed on March 27, 2008. The claims present in the application at that time also included method steps that were not illustrated via a flow chart.

However, the Examiner issued a new objection to the drawings in the Final Office Action mailed on April 20, 2009 (hereafter "the Office Action"). Applicants have amended the drawings to add a new Figure 3 that illustrates the steps of the method of claim 16, which also provides support for the sequence of steps that are performed by the different modules and the evaluator of the network of claim 28. The amended drawing of Figure 3 does not add new matter to the application.

The amended drawing adding Figure 3 to the application provides a drawing as required by the Examiner's objection to the drawings. The objection to the drawings should be withdrawn.

II. RESPONSE TO THE REJECTION OF CLAIMS 16, 21 AND 23-30

The Examiner rejected claims 16, 21 and 24-30 as obvious in view of the combination of WIPO Publication No. WO 01/20855 to Etsuo and U.S. Patent Application Publication No. 2003/0023697 to Okada. (Office Action at 3). The Examiner rejected claim 23 as obvious in

view of the combination of Etsuo, Okada and Japan Patent No. JP 11232188 to Yoshihiro. (Office Action, at 9).

A. Burden Of Proving Obviousness Under 35 U.S.C. § 103

"**All words in a claim must be considered in judging the patentability of that claim against the prior art**." MPEP § 2143.03 (emphasis added). "When evaluating claims for obviousness under 35 U.S.C. 103, **all the limitations of the claims must be considered and given weight**." MPEP § 2143.03. "If an independent claim is nonobvious under 35 U.S.C. 103, then any claim depending therefrom is nonobvious." *Id.* "A 35 U.S.C. 103 rejection is based on 35 U.S.C. 102(a), 102(b), 102(e), etc. depending on the type of prior art reference used and its publication or issue date." MPEP § 2141.01.

To establish a *prima facie* case of obviousness, an Examiner must show that an invention would have been obvious to a person of ordinary skill in the art at the time of the invention. MPEP § 2141. "Obviousness is a question of law based on underlying factual inquiries." *Id.* The factual inquiries enunciated by the Court include "ascertaining the differences between the claimed invention and the prior art" and "resolving the level of ordinary skill in the pertinent art." MPEP § 2141.

"A statement that modifications of the prior art to meet the claimed invention would have been 'well within the ordinary skill of the art at the time the claimed invention was made' because the references relied upon teach that all aspects of the claimed invention were individually known in the art is not sufficient to establish a *prima facie* case of obviousness without some objective reason to combine the teachings of the references." MPEP § 2143.01. "[R]ejections on obviousness cannot be sustained by mere conclusory statements; instead**, there must be some**

articulated reasoning with some rational underpinning to support the legal conclusion of obviousness." MPEP § 2143.01 (citing *KSR*, 550 U.S. at ___, 82 U.S.P.Q.2d at 1396) (emphasis added).

For instance, an invention that permits the omission of necessary features and a retention of their function is an indicia of nonobviousness. *In re Edge,* 359 F.2d 896, 149 U.S.P.Q. 556 (CCPA 1966); MPEP 2144.04. A conclusory statement to the contrary is insufficient to rebut such an indicia of nonobviousness. *See* MPEP § 2143.01.

Moreover, "[i]f the proposed modification or combination of the prior art would change the principle of operation of the prior art invention being modified, then the teachings of the references are not sufficient to render the claims prima facie obvious." MPEP § 2143.01. Also, "the proposed modification cannot render the prior art unsatisfactory for its intended purpose." MPEP § 2143.01.

B. Claims 16, 21 And 24-27 Are Allowable Over Etsuo Combined With Okada

Claim 16 defines a method that includes the step of assigning a unique identifier to the message that indicates that a message to be relayed is on the sender data terminal. The identifier includes a plurality of subidentifiers, each of which is assigned to at least one message element contained in a relayed message. The defined method of claim 16 also includes the step of sending a test message including the subidentifiers from a first mail processing device to a second mail processing device assigned to a recipient address data terminal. The method of claim 16 also includes the step of evaluating in the second mail processing device the test message sent by the first mail processing device. The evaluating is configured to process each subidentifier in the test message relative to data present in the second mail processing device

indicative of respective message elements previously relayed to the recipient address data terminal.

The method of claim 16 also includes the step of sending an evaluation-result of the test message from the second mail processing device to the first mail processing device. The evaluation-result of the test message indicating to the first mail processing device to transmit message elements evaluated as not previously relayed to the recipient address data terminal to the second mail processing device and further indicating to block message elements evaluated as previously relayed to the recipient address data terminal from being transmitted to the second mail processing device.

The method of claim 16 also includes the step of transmitting or blocking a transmission of respective ones of the message elements to the second mail processing device in response to the evaluation-result of the test message. The transmitting or blocking of respective ones of the message elements is in response to the evaluation-result of the test message and is configured to suppress a duplicative reception by the recipient address data terminal of a message element present in a message previously received by the recipient address. The transmitting or blocking is also configured to ensure that an amended message element of a message element present in the previously received message is transmitted to the recipient address.

Claims 21 and 24-27 depend directly or indirectly from claim 16 and, therefore, also contain the limitations of claim 16.

1. Etsuo Combined With Okada Does Not Teach Or Suggest Sending A Test Message Including The Subidentifiers From A First Mail Processing Device To A Second Mail Processing Device Assigned To A Recipient Address Data Terminal

The Examiner correctly reads Etsuo as not disclosing the sending of a test message that includes subidentifiers as required by claims 16, 21 and 23-27. (Office Action, at 6). The Examiner contends that Okada discloses or suggests such a limitation. (Office Action, at 6). The Examiner has incorrectly interpreted Okada.

Okada teaches an electronic mail composing device that has an editing unit for editing electronic mail by setting either to attach content of at least one attachment file or to notify only a title of the attachment file. (¶ 8). Such an email as taught by Okada is not a test-message. Nor is the electronic message sent from one communication device 1 to another communication device 2 a message sent from one mail processing device to another mail processing device.

A test message is a message that is sent from one processing device to another processing device that includes identifiers to indicate that provides indicators indicating different elements of a message to be sent to a recipient. However, the "Contents of the message elements are not also sent." Thus, the body of text within an email is not sent via a test message. To the contrary, identifiers representing different elements within a message are sent in a test message.

The message disclosed by Okada is not a test message. To the contrary, the message taught by Okada contains text from within the body of an electronic message. Indeed, all the content of the electronic message is sent other than an attached file. (¶10). Such a message cannot be considered a test message. To the contrary, it is an electronic message.

a. Okada Does Not Teach Or Suggest Test Message Transmissions Between First and Second Mail Processing Devices

Further, the test messages of claims 16, 21 and 23-27 are sent from a first mail processing device to a second mail processing device. Such devices are not user terminals. To the contrary, such devices are mail servers or other mail processing devices.

Okada does not teach or suggest that a test message is sent between mail processing devices. Okada only teaches or suggests the sending of an email without an attachment from one terminal (communication device 1) to a second terminal (communication device 2) via a mail server (mail server 3). (Figure 1, ¶¶ 19-23). Okada does not teach or suggest any test message transmitted between mail processing devices.

2. Etsuo Combined With Okada Does Not Teach Or Suggest Sending An Evaluation-Result Of The Test Message From The Second Mail Processing Device To The First Mail Processing Device

The Examiner also cited Okada as disclosing the sending of an evaluation-result of the test message from a second mail processing device to a first mail processing device. (Office Action, at 6). To the contrary, Okada does not teach any mail processing device evaluating a test message. As discussed above, Okada does not teach or suggest any test message and also does not teach or suggest the sending of a test message from a first mail processing device to a second mail processing device.

Further, Okada does not teach or suggest a second mail processing device evaluating a test message nor sending an evaluation-result of a test message. Okada only discloses a second communication device, or user terminal, that receives an electronic message that includes a link

to an attachment file. The attachment file may then be received by the user terminal if that user requests the file by accessing the link. (¶¶ 26-27).

3. Etsuo Combined With Okada Does Not Teach Or Suggest Transmitting Or Blocking A Transmission Of Respective Ones Of The Message Elements To The Second Mail Processing Device In Response To The Evaluation-Result Of The Test Message

The Examiner also contends that only Okada teaches or suggests the transmitting or blocking of a transmission of respective ones of the message elements to a second mail processing device in response to an evaluation-result of the test message. (Office Action, at 6). To the contrary, Okada does not teach or suggest any evaluation by a second mail processing device nor the sending of an evaluation-result by a second mail processing device.

Moreover, Okada does not teach or suggest the blocking or transmission of respective ones of the message elements to a second mail processing device. Okada teaches that a communication device, such as a user terminal, edits an email to replace an attachment file with the title of that file that includes a link that permits the sending of a forwarding demand. (¶¶ 22, 24, 26-27). The attachment file is not initially sent in such an electronic message because it is replaced with the link by an editing unit 12 that is in the communication device 1. (¶¶ 20-22).

There is no blocking of any message element by a mail processing device taught or suggested by Okada. To the contrary, Okada only teaches that the replacement of an attachment file with a title linked for permitting forwarding requests is provided by an editing unit 12 of a communication device 1, or user terminal. (¶¶ 20-22). As discussed above, a mail processing device is not a terminal such as the communication device 1 taught by Okada.

4. Okada Cannot Be Combined With Etsuo

Etsuo discloses a device that requires a mail processing device, such as mail server 300, to determine whether or not an electronic message it received from a client has the exact same text as a previous email sent from that client to another client. If the exact same text is present, the mail server 300 issues a no reception notice to the addressed client so that client does not receive the notices for electronic mails containing the identical text. (Etsuo - English translation Abstract, p. 10, lines 15-22).) The system disclosed by Etsuo requires the use of a mail server and requires all the processing to be done by just one mail server to determine if that email was previously sent to another client. (Etsuo - English translation p. 13, lines 2-8). There is no interaction with a second mail processing device. Nor is there any test message or evaluation-result messages transmitted in the system disclosed by Etsuo.

In contrast to the system disclosed by Etsuo, Okada requires an email to avoid having an attachment by an editing unit of a communication device 1 removing the attachment and replacing it with a linked title. (Okada, ¶¶ 20-2, 24, 26-27). The system disclosed by Okada requires a mail server to not be used for such replacement. Further, the system disclosed by Okada requires that the attached file and all the processing occurs locally on the communication device 1.

Changing the system disclosed by Okada to interact with the mail server to block transmission of message elements impermissibly modifies the principle of operation of the invention of Okada, the local editing unit 12. This is impermissible. MPEP § 2143.01 ("[i]f the proposed modification or combination of the prior art would change the principle of operation of

the prior art invention being modified, then the teachings of the references are not sufficient to render the claims prima facie obvious.").

5. Okada And Etsuo Teach Away From The Claims

Further, Etsuo and Okada both clearly teach away from the claims. Neither Okada nor Etsuo teach the use of any test message sent between mail processing devices nor an evaluation result sent between the mail processing devices. Indeed, both Okada and Etsuo only teach a system that utilizes one mail processing device, a mail server.

Moreover, both Okada and Etsuo, teach that only one device is involved in determining whether to not transmit an attached file (Okada) or whether to not transmit a reception notice (Etsuo). The system of Etsuo utilizes a server that determines whether an email receipt notice should not be sent to a client. (Etsuo - English translation p. 36, lines 3-18; p. 40, lines 20-22). The system of Okada uses an edit device 12 of a communication device to determine whether to send or not send an attachment file. Such systems teach away form the sending of test messages to a second mail processing device and also teach away from the use of any evaluation of test messages or sending of an evaluation result by a second mail processing unit. Indeed, both Okada and Etsuo teach that only one mail processing device should be used to achieve the functionality provided in their systems.

Clearly the combination of Etsuo and Okada cannot render the pending claims 16, 21, and 24-27 obvious. In fact, this combination of art clearly teaches away from the claimed method.

C. Claims 28-30 Are Allowable Over Etsuo Combined With Okada

Claim 28 defines a network that includes an assigning module configured to assign a unique identifier to the message that indicates that a message to be relayed is on the sender data terminal or in the first mail processing device. The identifier includes a plurality of subidentifiers, each of which is assigned to at least one message element contained in a relayed message. The network of claim 28 also includes a test message sensing module configured to send a test message including the subidentifiers from the first mail processing device to a second mail processing device assigned to a recipient address data terminal. The network of claim 28 also includes an evaluator configured to evaluate in the second mail processing device the test message sent by the first mail processing device. The evaluating is configured to process each subidentifier in the test message relative to data present in the second mail processing device indicative of respective message elements previously relayed to the recipient address data terminal.

The network of claim 28 also includes a sending module configured to send an evaluation-result of the test message from the second mail processing device to the first mail processing device. The evaluation-result of the test message indicating to the first mail processing device to transmit message elements evaluated as not previously relayed to the recipient address data terminal to the second mail processing device and also indicating to block message elements evaluated as previously relayed to the recipient address data terminal from being transmitted to the second mail processing device. A module configured to transmit or to block a transmission of respective ones of the message elements to the second mail processing device in response to the evaluation-result message is also included in the network of claim 28.

The transmission or block of respective ones of the message elements in response to the evaluation-result of the test message is configured to suppress a duplicative reception by the recipient address data terminal of a message element present in a message previously received by the recipient address. The transmission or block of respective ones of the message elements is also configured to ensure that an amended message element of the message element present in said previously received message is transmitted to the recipient address.

Claims 29-30 depend directly or indirectly from claim 28 and, therefore, also contain the limitations of claim 28.

1. Etsuo Combined With Okada Does Not Teach Or Suggest Sending Of Test Messages, Sending Evaluation Results Of Test Messages Nor The Transmission Or Block Of Respective Ones Of Message Elements As Required By Claims 28-30

As discussed above with reference to claims 16, 21 and 23-27, the cited art fails to teach or suggest sending of test messages, sending evaluation results of test messages, and also fails to teach or suggest the transmission or block of respective ones of message elements. Therefore, the cited art cannot render the pending claims obvious.

Moreover, the cited art cannot be combined because the combination required by the Examiner impermissibly alters the principle mode of operation for the invention of Okada. Finally, the cited art teaches away from the pending claims, which also shows the pending claims are not rendered obvious by the cited art.

For at least the above reasons, the rejection of claims 28-30 should be withdrawn.

D. Claim 23 Is Allowable

As discussed above, claim 16 is allowable over the cited art. Claim 23 depends from claim 16. Therefore, claim 23 is allowable at least because the claim from which claim 23 depends, claim 16, is allowable.

III. CONCLUSION

For at least the above reasons, reconsideration and allowance of all pending claims is respectfully requested.

Respectfully submitted,

/Ralph G. Fischer/

Dated: August 10, 2009

Ralph G. Fischer
Registration No. 55,179
BUCHANAN INGERSOLL & ROONEY PC
One Oxford Centre
301 Grant Street
Pittsburgh, Pennsylvania 15219

(412) 392-2121

Attorney for Applicant